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| 10/626,402 | 07/24/2003 | Masaki Kamiya | P/1927-10200 | 1069 |
| 2352 | 7590 | 11/01/2005 | EXAMINER | |
| OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403 | | | ADDY, ANTHONY S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2681 | |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,402

Applicant(s)

KAMIYA, MASAKI

Examiner

Anthony S. Addy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on August 10, 2005.

Claims 1-33 are pending in the present application.

Response to Arguments

2. Applicant's arguments filed on August 10, 2005 have been fully considered but they are not persuasive.

With respect to applicants' argument that Oosterholt fails to teach "said reference information having been automatically created in a normal operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in a communication mode of said communication terminal" by arguing that "Oosterholt, whose teaching is for web applications is deficient to teach automatic creation of reference information in a normal operation" examiner respectfully disagrees and maintains that Oosterholt meets the claimed limitation of "said reference information having been automatically created in a normal operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in a communication mode of said communication terminal." According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium (see paragraph 0018, lines 10-17 and Fig. 1;

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shows a personal computer 101 connected to a remote internet server 102). Thus it is clear from the teachings of Oosterholt that the web pages which is equivalent to a past-referred to file or data, can be referenced whether the personal computer is communicating over an external network [i.e. with the remote server] or while the personal computer is not communicating over an external network, since Oosterholt teaches "the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium."

With respect to applicants' argument that "normal operation mode encompasses operation while the computer is not communicating over an external network," examiner reiterates that it is unclear what constitutes a normal operation mode, since applicants' specification refers to "the mobile communication terminal is transitioned from the normal communication mode into the stand-by mode," thus meaning the mobile communication terminal in the "normal communication mode" is communicating which is substantially different from applicants' definition of a normal operation mode as encompassing operation while the computer is not communicating over an external network, as set forth in applicant's remarks filed on August 10, 2005 (see page 34, lines 3-5).

In view of the above, the 35 U.S.C. 103(a) rejections using **Nielsen et al** and **Oosterholt et al** with regards to claims 1-33 are proper and are maintained as repeated below. The rejections are made **FINAL**.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nielsen et al., U.S. Publication Number 2001/0030663 A1 (hereinafter Nielsen)**, and further in view of **Oosterholt et al., U.S. Publication Number 2001/0008399 A1 (hereinafter Oosterholt)**.

Regarding claim 1, Nielsen teaches a communication terminal accessible to a communication network (see paragraph 0032, lines 3-9, paragraph 0026, lines 6-10 and paragraph 0042, lines 3-5), said communication terminal including: a display unit (see paragraph 0026, lines 3-5 and Figures 1 & 2; where a display unit [LCD 3] is shown); and a control unit configured to control said display unit in displaying, in a stand-by mode of said communication terminal (see paragraph 0034, line 1 through paragraph 0035, line 3, paragraph 0039, lines 6-18, Fig. 2; where a control unit [processor 18] configured to control display unit [LCD 3] is shown, and Fig. 4a; where layout 30 as presented on LCD 3, showcases the phone in an idle mode), at least one of: a first display mark which provides a reference information linked to past-referred to data stored in said communication terminal (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60 on LCD 3 enables the user of the phone to access a built in phone book which reads on past-referred data stored in the phone); and a second display mark which provides at least one executable function related to said past-referred to data (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line

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1 through paragraph 0043, line 9 and Fig. 4a; shows the steps of selecting among several different menu items [Names 60 or Menu 55] listed on LCD 3 when the phone is in an idle mode).

Nielsen, however, fails to explicitly teach a third display mark which provides an access-related information allowing said communication terminal to have an access to a past-referred to file stored in a computer device connected to said communication network, and said access-related information being linked to said file; and a fourth display mark which provides at least one executable function related to said past-referred to file, said reference information having been automatically created in a normal operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in communication mode of said communication terminal.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web-pages may be selected by a history means, which maintain a list of references

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to web-pages which have been presented earlier or which are included in a user compiled set (see paragraph 0019, line 1-4). One of ordinary skill in the art further recognizes that it is clear from the teachings of Oosterholt that the web pages which is equivalent to a past-referred to file or data, can be referenced whether the personal computer is communicating over an external network [i.e. with the remote server] or while the personal computer is not communicating over an external network, since Oosterholt teaches "the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium."

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt to include a third display mark which provides an access-related information allowing said communication terminal to have an access to a past-referred to file stored in a computer device connected to said communication network, and said access-related information being linked to said file; and a fourth display mark which provides at least one executable function related to said past-referred to file, said reference information having been automatically created in a normal operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in a communication mode of said communication terminal, in order to enable a user of the computer device to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Regarding claims 12 and 23, Nielsen teaches a program to be executed to implement a method of controlling a communication terminal accessible to a communication network (see paragraph 0032, lines 3-9, paragraph 0026, lines 6-10 and Figures 3, 4a & 4b), said program and method including: displaying, in a stand-by mode of said communication terminal (see paragraph 0034, line 1 through paragraph 0035, line 3, paragraph 0039, lines 6-18, Fig. 2; where a control unit [processor 18] configured to control display unit [LCD 3] is shown, and Fig. 4a; where layout 30 as presented on LCD 3, showcases the phone in an idle mode), at least one of: a first display mark which provides a reference information linked to past-referred to data stored in said communication terminal (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60 on LCD 3 enables the user of the phone to access a built in phone book which reads on past-referred data stored in the phone); and a second display mark which provides at least one executable function related to said past-referred to data (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a; shows the steps of selecting among several different menu items [Names 60 or Menu 55] listed on LCD 3 when the phone is in an idle mode).

Nielsen, however, fails to explicitly teach a third display mark which provides an access-related information allowing said communication terminal to have an access to a past-referred to file stored in a computer device connected to said communication network, and said access-related information being linked to said file; and a fourth display mark which provides at least one executable function related to said past-referred to file, said reference information having been automatically created in a normal

operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in communication mode of said communication terminal.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server or if the page is already available locally, retrieve it from an internal storage medium (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web-pages may be selected by a history means, which maintain a list of references to web-pages which have been presented earlier or which are included in a user compiled set (see paragraph 0019, line 1-4) and the method can be implemented by means of hardware comprising several distinct elements, and by means of a suitably programmed computer (see paragraph 0028, lines 1-3). One of ordinary skill in the art further recognizes that it is clear from the teachings of Oosterholt that the web pages which is equivalent to a past-referred to file or data, can be referenced whether the personal computer is communicating over an external network [i.e. with the remote server] or while the personal computer is not communicating over an external network, since Oosterholt teaches "the retrieval means may download the requested page from a

remote server or if the page is already available locally, retrieve it from an internal storage medium.”

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt to include a third display mark which provides an access-related information allowing said communication terminal to have an access to a past-referred to file stored in a computer device connected to said communication network, and said access-related information being linked to said file; and a fourth display mark which provides at least one executable function related to said past-referred to file, said reference information having been automatically created in a normal operation mode of said communication terminal when said past-referred to data was referred to, and said past-referred to file having been referred to in a communication mode of said communication terminal, in order to enable a user of the computer device to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Regarding claims 2-3,13-14, and 24-25, Nielsen in view of Oosterholt teaches all the limitations of claims 1,12 and 23. Nielsen fails to explicitly teach said access-related information includes an address and said computer device comprises a server computer.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier

defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web pages may be represented by a number of web addresses (see paragraph 0021, lines 1-4).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt, wherein said access access-related information includes an address and said computer device comprises a server computer to enable a user of the personal computer to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Regarding claims 4,15, and 26, Nielsen in view of Oosterholt teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a communication terminal, program and method, wherein said communication terminal comprises a mobile communication terminal (see paragraph 0032, lines 1-9, paragraph 0026, lines 1-10 and Fig. 1).

Regarding claims 5,16, and 27, Nielsen in view of Oosterholt teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a communication terminal, program and method, wherein said past-referred to data are displayed upon selection of said first display mark (see paragraph 0039, lines 18-25 and Fig. 4a; where Names 60 [first display mark] on LCD 3 enables the user of the phone to access a built in phone book which reads on the past-referred to data stored in the phone).

Regarding claims 6,17, and 28, Nielsen in view of Oosterholt teaches all the limitations of claims 1,12 and 23. Nielsen further teaches a communication terminal, program and method, wherein at least one executable function related to said past-referred to data is displayed upon selection of said second display mark (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-3, paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a; shows the steps of selecting among several different menu items [Names 60 or Menu 55] and Browser 70 reads on a second display mark, since if chosen by the user after referring to either Names 60 or Menu 55 [first display mark], provides an executable related function and causes a selection of different menus related to reference information stored under Names 60 or Menu 55 in the phone).

Regarding claims 7,18, and 29, Nielsen in view of Oosterholt teaches all the limitations of claims 1,12 and 23. Nielsen fails to explicitly teach said communication terminal re-accesses said past-referred to file in said computer device upon selection of said third display mark.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches

web-pages may also be selected by means of a history means, which maintain a list of references to web-pages which have been presented earlier or which are included in a user compiled set (paragraph 0019, lines 1-4).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt, such that said communication terminal re-accesses said past-referred to file in said computer device upon selection of said third display mark to enable a user of the computer device to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Regarding claims 8, 19, and 30, Nielsen in view of Oosterholt teaches all the limitations of claims 1, 12 and 23. Nielsen fails to explicitly teach a list of said at least one executable function related to said past-referred to file is displayed upon selection of said fourth display mark.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web-pages may be selected by a history means, which maintain a list of references

to web-pages which have been presented earlier or which are included in a user compiled set (see paragraph 0019, line 1-4).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt, such that a list of said at least one executable function related to said past-referred to file is displayed upon selection of said fourth display mark to enable a user of the computer device to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Regarding claims 9, 20, and 31, Nielsen in view of Oosterholt teaches all the limitations of claims 1, 12 and 23. Nielsen further teaches a communication terminal, program and method, wherein if further data of the same kind as past-referred to data are referred to after said past-referred to data have been referred to, then an additional first display mark which provides an additional reference information linked to said further data is displayed, instead of said first display mark (see paragraph 0039, lines 18-25, paragraph 0040, lines 1-4 and paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a).

Regarding claims 10, 21, and 32, Nielsen in view of Oosterholt teaches all the limitations of claims 1, 12 and 23. Nielsen further teaches a communication terminal, program and method, wherein if further data of a different kind from said past-referred to data are referred to after said past-referred to data have been referred to, then not only said first display mark which provides said reference information linked to said past-referred to data, but also an additional first display mark which provides an additional reference information linked to said further data are displayed (see paragraph 0039,

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lines 18-25, paragraph 0040, lines 1-4 and paragraph 0042, line 1 through paragraph 0043, line 9 and Fig. 4a).

Regarding claims 11, 22, and 33, Nielsen in view of Oosterholt teaches all the limitations of claims 1, 12 and 23. Nielsen fails to explicitly teach if a further file to said past-referred to file is referred to after said past-referred to file has been referred to, then an additional third display mark which provides an additional access-related information allowing said communication terminal to have an access to said further file is displayed, instead of said file.

Oosterholt, however, teaches a personal computer accessible to a communication network, wherein the personal computer enables a user to browse web pages by means of a bookmark (see paragraph 0017, lines 1-5, paragraph 0018, lines 10-11). According to Oosterholt, the user may select a bookmark from a list of earlier defined bookmarks, which causes a retrieval means to retrieve a webpage referenced by the selected bookmark and the retrieval means may download the requested page from a remote server (see paragraph 0018, lines 10-17 and Fig. 1; shows a personal computer 101 connected to a remote internet server 102). Oosterholt further teaches the web-pages may be selected by a history means, which maintain a list of references to web-pages which have been presented earlier or which are included in a user compiled set (see paragraph 0019, line 1-4). In Figures 3-4, Oosterholt teaches a method of selecting an additional page E after referring to said past-referred file X, wherein an additional bookmark (page E), which provides an additional access-related information allowing said communication terminal to have an access to said further file

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is shown in the figures (see paragraph 0022, line 1 through paragraph 0025, line 11 and Figures 3-5).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to modify Nielsen with Oosterholt, such that a further file to said past-referred to file is referred to after said past-referred to file has been referred to, then an additional third display mark which provides an additional access-related information allowing said communication terminal to have an access to said further file is displayed, instead of said file, in order to enable a user of the computer device to reference a list of web-pages presented earlier and stored on a remote server as taught by Oosterholt.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

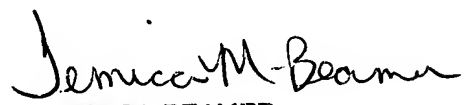
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S. Addy whose telephone number is 571-272-7795. The examiner can normally be reached on Mon-Thur 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony S. Addy
October 28, 2005



TEMICA BEAMER
PRIMARY EXAMINER
10/28/05